

REMARKS

After entry of this Amendment, the pending claims are: claims 1, 3, 5, 7-32. The Applicant would first like to thank the Examiner for the allowance of the subject matter disclosed in claims 12-15 if rewritten in independent form. The Office Action dated December 11, 2003 has been carefully considered. Claims 1, 24, and 29 have been amended. No new matter has been added. Reconsideration and allowance of the present application in view of the above amendments and the following remarks is respectfully requested.

In the Office Action dated December 11, 2003, the Examiner:

- rejected claims 1, 3, 5, 24-32, 25, 29-30 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 5,152,790 to Rosenberg *et al.* ("Rosenberg");
- rejected claims 7-11 under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg in view of United States Patent No. 5,643,267 to Hitomi *et al.* ("Hitomi");
- rejected claims 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg in view of United States Patent No. 6,129,763 to Chauvin *et al.* ("Chauvin");
- rejected claims 26-28 under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg in view of United States Patent No. 6,159,244 to Suddaby ("Suddaby"); and
- objected to claims 12-15 as being dependent upon a rejected base claim, but otherwise allowable if rewritten in independent form.

Independent Claim 1

Independent claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg. Independent claim 1 has been amended to recite, *inter alia*, a fixation device comprising an implant body having a recess and a graft interface member having an implant coupling portion, at least a portion of the coupling portion is configured and adapted to be received in the recess to permit the implant body to rotate independently of the graft interface member; wherein the implant coupling portion comprises a snap-fit type

connection. There is no disclosure, teaching or suggestion of a fixation device comprising an implant body having a recess and a graft interface member having an implant coupling portion, at least a portion of the coupling portion is configured and adapted to be received in the recess; wherein the implant coupling portion comprises a snap-fit type connection. Rather, Rosenberg discloses a threaded sleeve member 22, a rotatable ring 20 and an insert member 18. The sleeve member 22 includes a leading end 34, a trailing end 36, and a bore 32 extending therebetween. The rotatable ring 20 has a first end, a second end and a bore extending therebetween while the insert member 18 has a cylindrical body 38 and a flange end 40. When assemble, the rotatable ring 20 is first placed onto the insert member 18 so that the cylindrical body 38 extends through the bore of the rotatable ring 20 and into the bore of the threaded sleeve member 22, wherein the cylindrical body 38 is welded to the threaded sleeve member 22. Thus, it is respectfully submitted that Rosenberg does not disclose, teach, or suggest all the limitations of independent claim 1. It is respectfully submitted that independent claim 1 is thus allowable over the cited prior art. Withdrawal of this rejection and allowance of independent claim 1 is respectfully requested.

Moreover, to expedite prosecution of the present invention, the Applicant respectfully submits that the Examiner's combination of Rosenberg and Hitomi to render obvious claims 7-11 (which disclose specific elements of a snap-fit type connection) is impermissible hindsight reconstruction. That is, in order to establish a prima facie case of obviousness, the Examiner bears the burden of establishing three basic criteria. First, the Examiner must show that there was some suggestion or motivation, either in the references themselves or in the knowledge generally available to one skilled in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all of the claim limitations. *See* MPEP § 2142; *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on the applicant's disclosure. Therefore, making a legal determination of obviousness does not mean that one can "pick and choose among the individual elements of assorted prior art references to recreate the claimed invention." *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 858 F.2d 878, 8 USPQ2d 1468 (Fed. Cir. 1988). Rather, the Examiner must show, not that each element existed in the prior art, but that some teaching or suggestion in the references made obvious the invention as a whole. *Carella v. Starlight Archery*, 804 F.2d 135, 231

USPQ 644 (Fed. Cir. 1986); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990).

It is respectfully submitted that the Examiner has not satisfied the burden of proving that there was some suggestion or motivation to combine Rosenberg which discloses, as previously described, a fixation device comprising a threaded sleeve member 22, a rotatable ring 20, and an insert member 18 wherein the pieces are held together by welding with Hitomi which is directed to a bone connector comprising a first joint and a second joint wherein the first and second joints are adapted and configured to be inserted into and secured to bone pieces on either side of an ostetome. It is submitted, that there is no suggestion or motivation in either reference to modify the fixation device of Rosenberg to include a snap-fit type connection as disclosed in Hitomi. Moreover, it is submitted that there was no suggestion or motivation within the knowledge generally available to one skilled in the art at the time of filing this application to modify the fixation device of Rosenberg to include a snap-fit type connection as disclosed in Hitomi. In fact, as acknowledged by the Examiner, Rosenberg discloses a graft interface member (20) which is not even configured to be received in the purported recess on the purported second end (34) of the purported implant body (22), as required by claim 1. Therefore, modifying the implant of Rosenberg to include a snap-fit type connection would in essence require one to totally redesign the fixation device disclosed in Rosenberg.

Rather, it is respectfully submitted, that the Applicants through their own effort and expense derived the device as claimed in independent claim 1. It is respectfully submitted that without the benefit of the Applicant's disclosure, it would not be obvious for one of ordinary skill in the art to redesign Rosenberg to include a snap-fit type connection as disclosed in Hitomi. One cannot simply use the Applicant's disclosure as a blueprint to pick and choose among the individual elements of assorted prior art references in order to combine the right references in the right way to achieve the Applicant's claimed invention. *Grain Processing Corp. v. American Maize-Products Corp.* 840 F.2d 902 (Fed. Cir. 1988). Thus, it is respectfully submitted that independent claim 1 is allowable over the cited prior art. Withdrawal of this rejection and allowance of claim 1 is respectfully requested.

Dependent claims 3, 5, 7-20 all ultimately depend from independent claim 1, thus, it is respectfully submitted that these claims are equally allowable. Allowance of claims 3, 5, 7-20 is therefore respectfully requested.

Independent Claims 24 and 29

Independent claims 24 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg. Independent claim 24 has been amended to recite, *inter alia*, providing a fixation device having a body portion connected to a graft interface portion by a snap-fit type connection. Independent claim 29 has been amended to recite, *inter alia*, providing a fixation device having a body portion connected by a snap-fit type connection to a graft interface portion. For reasons similar to those described above with respect to independent claim 1, it is respectfully submitted that independent claims 24 and 29 are allowable over the cited prior art. Withdrawal of these rejections and allowance of claims 24 and 29 is respectfully requested.


Dependent claims 25-28 all ultimately depend from independent claim 24, thus, it is respectfully submitted that these claims are equally allowable. Allowance of claims 25-28 is therefore respectfully requested.

Dependent claims 30-32 all ultimately depend from independent claim 29, thus, it is respectfully submitted that these claims are equally allowable. Allowance of claims 30-32 is therefore respectfully requested.

In light of the above amendments and remarks, it is respectfully submitted that claims 1, 3, 5, 7-32 are now in condition for allowance, and the Examiner is respectfully requested to reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at 212-790-6348, if a telephone call could help resolve any remaining issues.

Date: February 11, 2004

Respectfully submitted,



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